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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,927	01/19/2001	Steve Hole	22048824-2	7420
26453	7590	03/27/2006	EXAMINER	
BAKER & MCKENZIE LLP 1114 AVENUE OF THE AMERICAS NEW YORK, NY 10036			LESNIEWSKI, VICTOR D	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/765,927	Applicant(s) HOLE, STEVE	
	Examiner Victor Lesniewski	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 1/13/2006 has been placed of record in the file.
2. No claims have been amended.
3. Claims 1-24 are now pending.
4. The declaration filed 1/13/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mathon et al. (U.S. Patent Application Publication Number 2001/0042131) reference. Thus, claims 1-24 remain rejected as presented in the previous actions dated 6/25/2004 and 7/14/2005.
5. After further search and consideration, new applicable prior art has been found. Thus, a new ground of rejection is also presented below. Accordingly, this action is non-final.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 1/13/2006 has been entered.

Response to Declaration

7. The declaration filed 1/13/2006 is ineffective because the evidence submitted is insufficient to establish conception and is insufficient to establish reduction to practice as discussed below.

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8. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mathon et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

9. The applicant is required to give a clear explanation of the exhibits pointing out exactly what facts are established and relied on. See MPEP 715.07. In the present declaration, the applicant sets forth "Exhibit A" in order to show conception of the invention as claimed, but the declaration does not describe where in the exhibit the recited limitations are found. Although the exhibit itself sets forth some mapping of computer code to claim language, the explanation should be presented in the declaration. Further, the applicant needs to more clearly explain what the functions of the code presented actually are (i.e. what the presented code is actually doing or performing) for many of the claims. For example, the section describing claim 14 appears to be somewhat well supported by stating a summarizing section of text and then setting forth the actual function in code with associated comments. On the other hand, the section describing claim 1 only sets forth a file name that the supposed functionality is encapsulated in and does not attempt to explain the functionality or describe what parts of the submitted computer code relate to the mentioned file. It is recommended that in mapping the computer code (in the exhibit) with the claim language (which should be discussed in the declaration itself) the applicant provide greater and clearer explanation as to where the claimed limitations can be found and as to how

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the code is actually functioning. Currently, all the claim limitations cannot be clearly identified in Exhibit A and thus conception cannot be established.

10. The evidence submitted is insufficient to establish a reduction to practice of the invention prior to the effective date of the Mathon et al. reference. Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See MPEP 715.07 and MPEP 2138. The declaration sets forth a statement that Exhibit A "represents a working version of message tracking parsing and monitoring application which existed prior to April 14, 2000." However, the declaration sets forth no explanation as to how the exhibit shows that the application actually existed and worked for its intended purpose. Exhibit A sets forth several pages of computer code that show output or data results, but it is unclear exactly what the results are and what they show in relation to the claimed invention. It is recommended that the applicant provide greater and clearer explanation as to what the data output is, what the data output means in relation to the claims, and the exact processes run in order to achieve such output. Currently, actual reduction to practice cannot be established from the declaration and Exhibit A.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al. (U.S. Patent Number 6,163,802), hereinafter referred to as Lin.

13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a program storage device are rejected under the same rationale applied to the described claim.

14. Lin has disclosed:

- <Claim 1>

A message tracking system, comprising: a message tracking monitor operable to monitor one or more ports for tracking information (figure 1, item 106 and column 3, lines 30-33); a message tracking interface coupled to the message tracking monitor (column 3, lines 44-47) and enabled to communicate with one or more decision support subsystems (figure 1, items 102 and 104, and column 3, lines 25-30), the message tracking interface operable to receive tracking information from the message tracking monitor and transfer the tracking information to one or more decision support subsystems (column 3, lines 44-47), wherein the tracking information is collected and managed (column 3, lines 13-19).

- <Claim 2>

The message tracking system as claimed in claim 1, wherein the one or more ports include any one or combination of electronic mail address, message tracking server, access status log, and proprietary message tracking API (column 4, lines 15-20).

- <Claim 3>

The message tracking system as claimed in claim 1, wherein the decision support subsystem includes a decision support database (figure 1, item 104).

- <Claim 4>

The message tracking system as claimed in claim 1, wherein the decision support subsystem includes a decision support application (column 3, line 60 through column 4, line 14).

- <Claim 5>

The message tracking system as claimed in claim 1, wherein the tracking information includes one or more tracking notifications (column 4, lines 43-50).

- <Claim 6>

The message tracking system as claimed in claim 1, wherein the message tracking interface is operable to access the tracking information stored in a decision support database (column 4, lines 28-50).

- <Claim 7>

The message tracking system as claimed in claim 1, wherein the message tracking interface is operable to update the tracking information stored in a decision support database (column 4, lines 28-50).

- <Claim 8>

The message tracking system as claimed in claim 1, wherein the message tracking interface is operable to manage the message tracking monitor (column 6, lines 10-30).

- <Claim 9>

The message tracking system as claimed in claim 1, wherein the system further includes one or more dynamically pluggable decision support interfaces (column 3, lines 48-59).

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- <Claims 10 and 21>

A method for tracking message, comprising: monitoring tracking information on one or more ports; collecting tracking information from the one or more ports (column 3, lines 13-19 and figure 1, item 106 and column 3, lines 30-33); and transmitting the tracking information for handling the tracking information according to a predetermined schema (column 3, lines 44-47).

- <Claim 11>

The method for tracking messages as claimed in claim 10, wherein the one or more ports include one or more electronic message tracking ports (column 4, lines 15-20).

- <Claim 12>

The method for tracking messages as claimed in claim 10, further including: parsing the tracking information into a record format (column 3, lines 44-47).

- <Claim 13>

The method for tracking messages as claimed in claim 10, wherein the predetermined schema includes storing in a decision support database (figure 1, item 104 and column 3, lines 25-27).

- <Claim 14>

The method for tracking messages as claimed in claim 10, wherein the predetermined schema includes real time exception handling (column 11, lines 1-6).

- <Claim 15>

The method for tracking messages as claimed in claim 10, wherein the transmitting includes transmitting the tracking information to a decision support subsystem (figure 1, items 102 and 104, and column 3, lines 25-30).

- <Claim 16>

The method for tracking messages as claimed in claim 10, wherein the one or more ports include one or more tracking ports (column 4, lines 15-20).

- <Claim 17>

The method for tracking messages as claimed in claim 10, further including providing analytical reports based on the collected tracking information (column 3, lines 66-67).

- <Claim 18>

The method for tracking messages as claimed in claim 10, wherein the monitoring includes requesting for one or more tracking notifications from one or more tracking sources (column 4, lines 43-47).

- <Claim 19>

The method for tracking messages as claimed in claim 10, wherein the monitoring includes accepting one or more tracking notifications from one or more tracking sources (column 4, lines 47-50).

- <Claim 20>

The method for tracking messages as claimed in claim 10, wherein the monitoring includes continuously monitoring tracking information ports (column 6, lines 58-65).

- <Claim 22>

A message tracking system, comprising: a message tracking monitor coupled to one or more message tracking data sources (figure 1, item 106 and column 3, lines 30-33), the message tracking monitor operable to receive tracking information from the one or more message tracking data sources and parse the tracking information into one or more tracking data records (column 3, lines 44-47); a message tracking interface (column 3, lines 44-47) coupled to the message tracking monitor and one or more decision support subsystems (figure 1, items 102 and 104, and column 3, lines 25-30), the message tracking interface operable to receive tracking data records and transmit the tracking data records to the one or more decision support subsystems (column 3, lines 44-47).

- <Claim 23>

The message tracking system as claimed in claim 22, further including: one or more dynamically pluggable decision support interface modules coupled to the message tracking interface and the one or more decision support subsystems (column 3, lines 48-59), wherein the one or more dynamically pluggable decision support interface modules in response to receiving the one or more tracking data records from the message tracking interface, transmit the one or more tracking data records to the one or more decision support subsystems (column 3, line 60 through column 4, line 14).

- <Claim 24>

The message tracking system as claimed in claim 22, wherein the tracking information includes message transactions on the Internet (column 12, lines 1-8).

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Since all the limitations of the invention as set forth in claims 1-24 were disclosed by Lin, claims 1-24 are rejected.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Gertner et al. (U.S. Patent Number 6,049,775) disclosed a system for remotely managing a plurality of remote mail processing devices.
- Leonard et al. (U.S. Patent Number 6,721,784) disclosed an email system that includes a central server which tracks messages and compiles information on the handling of the message by each user.
- Hammond (U.S. Patent Number 6,854,007) disclosed a system for enhancing email reliability that tracks whether each message has been delivered to each recipient.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

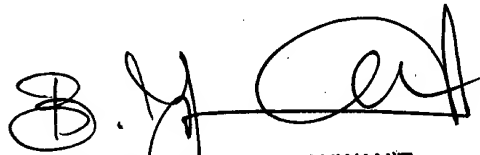
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER